REMARKS

Claims 21 through 42 and 44 through 90 are pending in the present application.

Claim 58 stands rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 21-28, 33-42, 44-52, and 57-90 stand rejected for non-statutory type double patenting over claims 1-3, 10-12, 14-15, and 27-28 of co-pending application number 09/676,374. Claims 21-28, 33-42, 44-52, and 57-90 stand rejected for non-statutory type double patenting over claims 1-10 of co-pending application number 10/607,418. Claims 21-42 and 44-90 stand rejected for non-statutory double patenting over claims 1-20 of U.S. patent 6,049,783.

Claims 21-26, 28, 33-42, 44-50, 52, 57-70, 72-90 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. patent 5,414838 (Kolton). Claims 27 and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Kolton in view of U.S. patent publication 2001/0056392 (Daughtery). Claims 29-31, 53-55 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kolton in view of U.S. patent 5,862,223 (Walker). Claims 32, 56, and 71 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kolton in view of U.S. patent 6,058,378 (Clark).

Applicants' undersigned representative respectfully requests reconsideration of the pending rejections.

Rejection Under 35 U.S.C. § 101

Claim 57 has been amended and now recites a server system comprising a database and computer executable instructions. Applicant respectfully submits that the claimed server system is patentable subject matter under 35 U.S.C. § 101. Reconsideration of the rejection is respectfully requested.

Double Patenting Rejections

The office action indicates that claims 21 through 42 and 44 through 90 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over

claims 1 through 20 of U.S. patent 6,049,783. Applicants' undersigned submits herewith a Terminal Disclaimer over U.S. patent 6,049,783. Applicants' request withdrawal of the double patenting rejection.

The undersigned acknowledges that *provisional* rejections were made over U.S. patent applications 09/676,374 and 10/607,418. However, the undersigned respectfully submits that under M.PE.P § 804, it is appropriate to withdraw a double patenting rejection in the earlier filed application where the later applications are still pending. Accordingly, the undersigned respectfully requests that because U.S. patent applications 09/676,374 and 10/607,418 are still pending, the double patenting rejection be withdrawn in the present application.

The Prior Art Rejections

The claims stand rejected under 35 U.S.C. 103(a) as allegedly being obvious over Kolton in view of Clark, Daughtery, and Walker. Reconsideration is respectfully requested.

The Claimed Methods and Systems

Applicants disclose novel services and methods for searching for financial instruments. The disclosed services and methods involve creating and maintaining a database reflecting current market conditions, creating user accounts, and allowing users to query the database to identify existing financial instrument investment opportunities. In a disclosed system, financial data reflecting current market conditions is retrieved over the Internet from at least one site. (Fig. 1; Col. 2, ll. 13-19; Col. 2, ln. 64-Col. 3, ln. 5). Calculations are performed on the financial data to create a searchable database reflecting the market conditions. (*Id.*) Individuals may establish accounts and store search criteria in connection with those accounts. (Col. 2, ll. 203-35; Col. 3, ll. 8-16). An individual may have the stored search criteria run against the database, and upon reviewing the results, may change the search criteria to explore different investment opportunities. (Col. 2, ll. 9-10).

Claim 21 is directed to a method of identifying financial instruments meeting user-defined investment criteria, comprising:

receiving financial instrument data from at least one data source, said financial instrument data reflecting current market conditions;

calculating using the financial instrument data values for a plurality of searchable parameters for particular financial instruments in said financial instrument data;

creating accounts for users wishing to identify financial instruments;

receiving user-defined search criteria for said searchable parameters;

storing in relation to the accounts the user-defined criteria for searching the searchable parameters;

comparing the user-defined search criteria with the values identified for the searchable parameters for the particular financial instruments;

identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria;

transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria;

receiving modified user-defined search criteria for said searchable parameters;

comparing the modified user-defined search criteria with the values identified for the searchable parameters for the particular financial instruments;

identifying at least one of the financial instruments having values for the searchable parameters matching the modified user-defined search criteria; and

transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the modified user-defined search criteria.

In order for the recited methods and claims to be anticipated or rendered obvious by a reference or a set of references, the references must teach the combination of all of the claimed elements, including those emphasized. Applicants' undersigned representative respectfully submits that the cited references do not even teach all of the claimed elements individually and certainly do not suggest the claimed combination.

The Cited References Do Not Render The Claims Obvious

Kolton discloses a "system for extracting ***historical*** market information with condition and attributed windows." (Title). Kolton explains that his "primary object" is to allow querying of a "database containing ***historical*** stock, commodity, and economic data." (Col. 1, ln. 56). Consistent with this "object," Kolton describes his system as allowing users to retrieve "the value of a commodity ***on given dates*** with search limitations relating to technical trading rules, holidays and historical events, business events, government reports, and even particular days of the week, month, or year." (Col. 2, ll. 11-15). Kolton's system allows for the generation of reports displaying the price of a known commodity on specific days over time. (Col. 2, ll. 16-25, Fig. 43b). Kolton teaches that graphing the historical price of a stock over time allows users to identify correlations between stock prices and particular dates or events. (Col. 13, ll. 57-63).

Thus, Kolton discloses a system wherein the commodity is ***known*** and users use the system to analyze price movements in the known commodity over time. (Col. 2, ll. 11-15; Col. 12, l-6; Fig. 43b; Fig. 5b; Fig. 6b; Fig. 7b; Fig. 8b, Fig. 9). This is in contrast to the recited systems and methods wherein the financial instrument is **not known** and users use the system to search for financial instruments that meet user search parameters. The very purpose of Kolton is different than that of the recited systems and methods.

Furthermore, Kolton's system relies upon searching ***historical*** market data to identify correlations between price movements for a commodity and calendar events. In contradistinction to the systems and methods recited in the claims, Kolton does not disclose systems and methods that employ timely ***current*** market data to allow for searching for current investments. In Kolton's system, because the data against which queries are run is historical data and the purpose is to identify correlations with past events, running the same query over time will always result in the same results. In other words, because the underlying data is the same, and assuming the search parameters are the same, the results will be the same. In contrast, in the systems and methods recited in the claims, because the financial data represents current market conditions, running the same query will likely result in different results as the underlying market conditions have changed.

Not only is the very purpose and basic premise of operation taught by Kolton different from that of the recited systems and methods, but Kolton fails to teach the recited claim

elements. Kolton simply does not teach "receiving financial instrument data from at least one data source, said financial instrument data reflecting current market conditions." Rather, Kolton teaches a database of ***historical data***, and not current market data as recited in the claims. (Col. 1, ln. 56). Furthermore, there is no teaching in Kolton that the data is received from another data source. Kolton teaches combining data into a database (Col. 2, ll. 25-38), but does not specify that the data is retrieved from another data source. Indeed, Kolton teaches a local application running on a workstation. (Col. 4, ll. 21-28). There is no indication that the workstation is even connected to a network and operable to receive data from another source.

Kolton also does not teach "calculating using the financial instrument data values for a plurality of searchable parameters for particular financial instruments in said financial instrument data" as recited in the claims. The Office Action notes that Kolton teaches a database of information. (Col. 5, ll. 8-44). Specifically, Kolton discloses a database containing individual stock price information, market averages information, economic indicator information, and the dates that have an influence on the market. (*Id.*) But none of these data items need to be calculated.

Kolton does not teach "identifying at least one of financial instruments having values for the searchable parameters matching the user-defined search criteria," "transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria," "identifying at least one of financial instruments having values for the searchable parameters matching the modified user-defined search criteria," and "transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the modified user-defined search criteria," as recited in the claims. Kolton teaches a system and method wherein the commodity is ***known*** and is, in fact, used as a search parameter to analyze price movements in the commodity over time. (Col. 2, ll. 11-15; Col. 12, l-6; Fig. 43b; Fig. 5b; Fig. 6b; Fig. 7b; Fig. 8b, Fig. 9). This is in contradistinction to the recited systems and methods wherein financial instruments are the things which is being searched for. Thus, in Kolton, to the extent there is any "identifying" and "transmitting," it is **not** for a financial instrument having values for the searchable parameters as recited in the claims, but rather for the *price* of a commodity that is *already known* at different points in the past.

The office action ***acknowledges*** that Kolton does not teach "creating accounts for users wishing to identify financial instruments; . . . and storing in relation to the accounts user-defined criteria for searching the searchable parameters."

With respect to claims 22, 46, 59, and 66, the Office Action alleges that Kolton discloses stock options. In truth, Kolton merely mentions options in the context of selecting specific calendar events (*i.e.* option expiration dates) that a user may wish to use in connection with analyzing the price of a stock over time. (Col. 7, ln. 39 – Col. 8, ln. 10). In Kolton, the commodity, *i.e.* stock, is known by the user and used as one of the search inputs. Kolton does not teach searching for financial instruments, and certainly does not teach searching for options.

With respect to claims 38-41, 63-64, and 77-80, the Office Action alleges that in Kolton the use of the Internet with web browser is utilized as a database to store parameters. However, Kolton does not even use the word Internet, let alone teach using it as a medium for gathering financial information, creating a database of searchable parameters, accepting user search criteria, and returning financial instruments, as recited by the claims.

Thus, Kolton teaches a system with an entirely different purpose than the recited systems and methods. Moreover, Kolton fails to teach, or even to suggest, most, if not all of the recited elements including those noted above.

Clark too does not teach the recited claim elements. Clark is directed to a method for integrating a plurality of financial services provided at different geographical locations and in different time zones, and electronically delivering such services directly to a customer facility at any time requested by the customer. (Abstract). In the system disclosed by Clark, customers connect to the system whenever desired to access each of the services, and messages are stored and routed between the customers and each of the service provides at the respective times when the customers' facilities and the service provider's facilities are operative. (*Id.*).

Thus, Clark teaches a system that allows customers to time-shift their interfacing with service providers. The system disclosed by Clark is not a system for identifying financial instruments meeting user-defined investment criteria as recited in the claims. Furthermore, the Office Action does not even allege that Clark teaches, in addition to the other recited elements, "receiving financial instrument data from at least one data source, said financial

instrument data reflecting current market conditions; calculating using the financial instrument data values for a plurality of searchable parameters for particular financial instruments in said financial instrument data; . . . receiving user-defined search criteria for said searchable parameters; . . .comparing the user-defined search criteria with the values identified for the searchable parameters for the particular financial instruments; identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria; transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria; receiving modified user-defined search criteria for said searchable parameters; comparing the modified user-defined search criteria with the values identified for the searchable parameters for the particular financial instruments; identifying at least one of the financial instruments having values for the searchable parameters matching the modified user-defined search criteria; and transmitting to the user for display data identifying at least one of the financial instruments having values for the searchable parameters matching the modified user-defined search criteria."

The Office Action alleges that Clark discloses "user accounts related to a financial service system." (Office Action ¶ 8). But Clark merely indicates that user identifiers in the header of messages are sent in an electronic system. (Col. 7, ll. 49-65). This is not what is recited in the claims. Clark does not teach or even suggest "creating accounts for users wishing to identify financial instruments; . . . and storing in relation to the accounts the user-defined criteria for searching the searchable parameters."

Furthermore, even if Clark taught the claimed elements, which it does not, there is no teaching to combine Clark with Kolton to form the claimed systems and methods. In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). There is no suggestion in Clark that its teachings should or could be used in another system, and more particularly one such as Kolton. Furthermore, if one were to combine Clark with Kolton, one

skilled in the art simply would not combine Kolton and Clark to arrive at the recited systems and methods. Rather, combining Clark with Kolton results in a system with the specialized user interface taught by Kolton, and which may also be used to time-shift the interfacing between customers and service providers, as taught by Clark.

Daughtery also fails to disclose the recited claim elements, and certainly does not suggest the claimed combinations. Indeed, the Daughtery discloses an apparatus and process for calculating and transacting options, and in particular, expirationless options. ¶31. But Daughtery does not disclose, or even suggest a method or system for searching for financial instruments comprising, in addition to the other recited elements, "requesting financial instrument data from at least one data source; receiving financial instrument data from at least one data source; calculating using the financial instrument data values for a plurality of searchable parameters for particular financial instruments in said financial instrument data; creating accounts for users wishing to identify financial instruments; and storing in relation to the accounts user-defined criteria for searching the searchable parameters." Accordingly, Daughtery cannot possibly anticipate or render obvious the recited methods and systems.

Furthermore, with respect to claims 27 and 51, the Office Action alleges that Daughter discloses Black-Scholes values for options. While it is true that Daughtery mentions the Black-Scholes equation, Daughtery does not disclose or even suggest that the Black-Scholes value is calculated for a plurality of financial instruments and the results used as a searchable parameter for locating financial instruments, as is recited in the claims.

Moreover, even if Daughtery had taught the claimed elements, which it does not, there is no teaching to combine Daughtery with Kolton and Clark to form the claimed systems and methods. Indeed, Daughtery is not even a system for searching, and most certainly not for searching for financial instruments. In view of the fact that Kolton is not a system for searching for unknown financial instruments, and Daughtery likewise is not such a system, there is simply no teaching or motivation to combine the two to create the claimed systems and methods.

Walker likewise fails to teach or suggest the emphasized claim elements, and cannot possibly render obvious the recited combinations. Walker discloses an apparatus and method for matching an expert having particular qualifications and an end user seeking a solution to an expert request. (Abstract). But Walker does not disclose or suggests a method or system

comprising, in addition to the other recited elements, "receiving financial instrument data from at least one data source; calculating using the financial instrument data values for a plurality of searchable parameters for particular financial instruments in said financial instrument data; creating accounts for users wishing to identify financial instruments; . . . and storing in relation to the accounts the user-defined criteria for searching the searchable parameters." Furthermore, even if Walker taught the claimed elements, which it does not, there is no teaching to combine Walker with Kolton to form the claimed systems and methods.

Therefore, because neither Kolton, Clark, Walker, nor Daughtery, either by themselves or considered together teach all of the recited elements, they cannot possibly anticipate or render obvious the recited systems and methods. Furthermore, even if the limitations could be found in the cited references, which they cannot, one skilled in the art would not be motivated to combine the references to arrive at the recited methods and systems. Each reference teaches a system totally unrelated to the others and there is no motivation to combine the teachings to arrive at the particular systems and methods that are recití. Accordingly, withdrawal of the prior art rejections is respectfully requested.

Conclusion

For all the foregoing reasons, Applicants respectfully submit that the pending claims are in condition for allowance. Reconsideration of the pending rejections and a Notice of Allowance are respectfully requested.

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